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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,928	03/30/2001	Thomas N. Turba	RA 5390 (33012/320/101)	8178

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Charles A. Johnson  
Unisys Corporation  
P O Box 64942 MS 4773  
St. Paul, MN 55164

EXAMINER

NGUYEN, MERILYN P

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 12/31/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/821,928

Applicant(s)

TURBA, THOMAS N.

Examiner

Merilyn P Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*.

### DETAILED ACTION

1. In response to the communication dated 10/23/2003, claims 1-20 are pending in this office action.

#### *Acknowledges*

2. Receipt is acknowledged of the following items from the Applicant:
- o The applicant's amendments have been considered and made of record as Paper No.
- 4.

#### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 6, 11, and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 11, and 16 of copending Application No. 09/822686. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations.

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Regarding claims 1, 6, and 16 of the instant application, these claims recite all the elements of claims 1, 6, and 16 of the '686 application, except that it further includes the limitation of presenting a plurality of valid steps as choices or selections for addition to each of plurality of discreet and independent steps. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the limitation of presenting a plurality of valid steps as choices or selections for addition to each of plurality of discreet and independent steps as claimed in the instant application, since with or without this limitation, the scope of the invention would not be changed. Furthermore, it's well known in the art that for each step there is always sub steps in order to a complete function. The motivation would have been to expand the overall use of claimed invention at no significant cost.

The subject matter of claims 2, 3, 5, 7-10, and 18-20 of the '686 application are the same as claims 2, 3, 5, 7-10, and 18-20 of instant application.

Regarding claim 11 of the instant application, this claim recites all the elements of claim 11 of the '686 application, except that it further includes the iteration/repetition of steps in claim 11 of '686 application. It would have been obvious to one having ordinary skill in the art at the time the invention was made to repeat or iterate the steps of '686 application as claimed in the instant application. The motivation would have been to expand the overall use of claimed invention at no significant cost.

The subject matter of claims 13, 14, and 15 of the '928 application are the same as claims 13, 14, and 15 of the instant application.

5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Beall (US 6,169,992).

Regarding claims 1 and 6, Beall discloses in a data processing system (Figs. 1-3) having a user terminal (Client Computer 4018) operated by a user which builds a service for accessing a data base management system responsively coupled to said user terminal via a publicly accessible digital data communication network (Col. 3, line 20 to Col. 4, line 27), the improvement comprising:

a Data Wizard (Figures 27-31) which permits said user to specify said service as an ordered sequence of discreet and independent steps and which presents a plurality of valid steps as choices for addition at each position in said plurality of discreet and independent steps (Col. 30, line 1 to Col. 31, line 11).

Regarding claims 2, 7, and 18, Beall discloses said publicly accessible digital data communication network further comprises the Internet (Internet 5124, Fig. 3).

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Regarding claims 3, 9, 13-14, and 20, Beall discloses said user terminal further comprises an industry compatible personal computer (Client Computer 4018, Fig. 3) having a commercially available browser (WWW Browser 4014, Fig. 3).

Regarding claims 4, 8, 12, and 17, Beall discloses said Data Wizard inhibits presentation of any step which would not be valid for the corresponding position within said ordered sequence (Col. 30, lines 6-7, wherein the presentation of any step is inhibited by using "cancel button").

Regarding claims 5, 10, 15, and 19, Beall teaches a commercial data base management system (See col. 3, lines 31-59).

Regarding claim 11, Beall discloses a method of dynamically building a service (Figs. 27-31) from a user terminal (Client Computer 4018, Fig. 3) coupled via a publicly accessible digital data network (Internet 5124, Fig. 3) to a remote data base management system having a component building process (Figs. 1-3, and Col. 3, line 20 to Col. 4, line 27). Beall teaches an ordered sequence of steps at Fig. 27 through Fig. 31. Beall presents plurality of potential steps within each of the ordered sequence of steps as example of Fig. 30, wherein there are steps of "select the knowledge base" and "select the class". After chosen the desired knowledge base and class, the user click "next" to proceed next one of the order sequence of steps (Fig. 31). This process repeats until user clicks "Finish" to complete the service.

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Regarding claim 16, Beall teaches an apparatus includes Client Firewall 5125 for permitting a user to access Internet 5124 (Fig. 5), so that data base management services is provided such as service for accessing a data base management system (Col. 3, line 20 to Col. 4, line 27). Designing a service through specification of an ordered plurality of discreet and independent steps and presenting a plurality of valid potential steps for selection of each of said ordered plurality of discreet and independent steps are addressed in the analysis above (Claim 11).

#### ***Response to Arguments***

7. Applicant's arguments filed on 10/23/03 with respect to claims 1-20 have been fully considered but they are considered moot in view of the new grounds of rejection.

Applicant's remarks regarding the provisional double patenting rejection are noted. However, absent a terminal disclaiming or amendment patentability differentiating the inventions, the rejection stands.

#### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 703-305-5177. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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December 24, 2003

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